

REMARKS

In response to the above-identified Office Action (“Action”), Applicants traverse the Examiner’s rejection of the claims and seek reconsideration thereof. Claims 38, 42, 46-57 and 60-66 are pending in the present application. Claims 38, 42, 46-57 and 60-66 are rejected. In this response, claims 38 and 57 are amended, claim 55 is cancelled and no claims are added.

I. Examiner Interview Summary

Applicants respectfully acknowledge with appreciation the Examiner’s granting of an interview via telephone on October 27, 2011. During the interview, the rejections raised in the Action as well as proposed amendments to overcome the art of record were discussed. The Examiner acknowledged that reciting a low concentration (e.g. 0.0003%-3%) of the oligonucleotide in the claims along with additional details as to why the low concentration provides surprising results, may be sufficient to overcome the art of record. No further agreements were reached during the interview.

II. Claim Amendments

Claims 38 and 57 are amended to recite that the oligonucleotide is present in the composition in an amount of between 0.0003% and 3%. Support for the amendments may be found, for example, at page 17, lines 20-25 of the Application. Applicants respectfully submit the amendments do not add new matter and are supported by the specification. Accordingly, Applicants respectfully request consideration and entry of the amendments to claims 38 and 57.

III. Sequence Listing

Applicants further submit herewith an amendment to the Sequence Listing to correct a typographical error in SEQ ID NO. 4. The correct oligonucleotide sequence for SEQ ID NO. 4 is recited at pages 11, 20 and 40 of the Application. Thus, the Listing is amended to correctly recite the SEQ ID NO. 4 oligonucleotide sequence recited at pages 11, 20 and 40 of the Application. Applicants respectfully request consideration and entry of the amendments to the Sequence Listing.

IV. Claim Rejections – 35 U.S.C. §103

A. In the Action, claims 38, 42, 46-57, and 60-67 are rejected under 35 U.S.C. §103(a) as being unpatentable over International Publication No. WO 95/02069 issued to Bennett et al. (“Bennett”), in view of Journal of Biological Chemistry, 1993, Vol. 268:16:11742-11749 of Park et al. (“Park”).

To establish a *prima facie* case of obviousness, the Examiner must set forth “some articulated reasoning with some rational underpinning to support the conclusion of obviousness.” See *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103*, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

In regard to independent claims 38 and 57, Applicants respectfully submit that Bennett and Park fail to disclose or render predictable a method of depigmenting or bleaching human skin, body hair or hair of a head including an oligonucleotide having SEQ ID NO. 4 in an amount of between 0.0003% and 3% of the composition as required by claims 38 and 57.

In the Action, the Examiner maintains the obviousness rejection in view of Bennett and Park, alleging that Bennett describes:

- i) PKC beta-1 modulating specific oligonucleotides,
- ii) psoriasis treatment (yet not necessary linked with PKC beta-1 isoform), and
- iii) all the steps of the method of the invention.

The Examiner however acknowledges that Bennett does not describe that PKC beta-1 modulating oligonucleotides are efficient for skin bleaching or depigmenting (see Action, pg. 5). Nevertheless, the Examiner alleges that the claimed method is inherently performed by reducing to practice that which is disclosed in Bennett. The Examiner maintains Bennett discloses and claims a method of targeting a condition associated with expression of PKC comprising administering to a mammal a therapeutically effective amount of an oligonucleotide specifically hybridizable with a PKC gene or mRNA, and discloses and claims that the condition associated

with the expression of PKC is a hyperproliferative disorder being psoriasis, and claims that the PKC gene is specifically PKC beta-1.

Applicants do not believe Bennett or Park disclose an oligonucleotide having SEQ ID NO. 4: GCC AGC ATC TGC ACC GTG AA. Bennett discloses on page 26 SEQ ID NO. 27: GCC AGC ATG TGC ACC GTG AA, however, SEQ ID NO. 27 does not appear to be the same as SEQ ID NO. 4: GCC AGC ATC TGC ACC GTG AA recited in original claim 43, and disclosed on pages 11, 20 and 40 of the Application. As previously pointed out, there was a typographical error in the oligonucleotide sequence for SEQ ID NO. 4 provided in the Sequence Listing as filed.

Moreover, even if it were possible to find that Bennett or Park discloses SEQ ID NO. 4, and Applicants do not believe it is, the references further fail to disclose a composition including SEQ ID NO. 4 in an amount of between 0.0003% and 3% of the composition as required by amended claims 38 and 57. As discussed at page 6, lines 15-20 of the Application, the Applicants found that oligonucleotides such as SEQ ID NO. 4 are capable of specifically hybridizing with the gene or produces of the genes coding for the PKC beta-1 isoform having a depigmenting activity, even at very low concentrations. Such activity at very low concentrations between 0.0003% and 3% is surprising and unexpected because typically antisense oligonucleotides are not sufficiently active at this concentration.

Since, for at least the foregoing reasons, the combination of Bennett and Park may not be relied upon to disclose each of the elements of claims 38 and 57, a *prima facie* case of obviousness may not be established. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 38 and 57 and their dependent claims under 35 U.S.C. §103 in view of Bennett and Park.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

PETITION FOR EXTENSION OF TIME

Per 37 C.F.R. 1.136(a) and in connection with the Office Action mailed on September 26, 2011, Applicants respectfully petition Commissioner for a three (3) month extension of time, extending the period for response to March 26, 2011. The amount of \$1,270.00 to cover the petition filing fee for a 37 C.F.R. 1.17(a)(3) large entity will be charged to our Deposit Account No. 02-2666.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on the date shown below.


Lareema Henderson

3/15/12
Date